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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,256	10/31/2003	Kazuo Okada	SHO-0054	9221

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EXAMINER	
SHAH, MILAP	

ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/697,256	OKADA, KAZUO	
	Examiner	Art Unit	
	Milap Shah	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 June 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☒ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 7-7-04, 11-19-04, 2-25-05, 4-28-5, 5-25-05
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on August 21, 2002. It is noted, however, that applicant has not filed a certified copy of the application as required by 35 U.S.C. 119(b).

Acknowledgment is made of applicant's claim for priority under 35 U.S.C. 119(a)-(d) based upon an application filed in Japan on August 21, 2002. A claim for priority under 35 U.S.C. 119(a)-(d) cannot be based on said application, since the United States application was filed more than twelve months thereafter, on October 31, 2003.

The Examiner confirms that both, a certified copy of the foreign application was not received and the filing for priority is more then twelve months past the filing of the foreign application. Therefore, priority is not given to the foreign application and the Examiner is examining the application as being filed on November 19, 2003.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225

USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of copending Application No. 10/644,955 and claims 1-8 of copending Application No. 10/715,494. Although the conflicting claims are not identical, they recite similar subject matter.

In the case of co-pending Application No. 10/644,955 it would have been obvious to one of ordinary skill in the art to broaden the claims of the instant application by removing the limitations pertaining to the controller and leaving only the limitations pertaining to the shielding means. Thus, the invention of that application and the instant application are considered the same invention.

In the case of co-pending Application No. 10/715,494, it would have been obvious to one of skill in the art to add broaden the claims of the instant application by removing the processor, and stop controller means by merely indicating the outcome is "selected" rather then determined via a stopping means, and further broadening the display disposed in front of the variable display. Thus, the invention of that application and the instant application are considered the same invention.

In view of the above, one of ordinary skill in the art would find it obvious to create either one of the other two inventions, given one of the inventions.

The Examiner acknowledges that there may be additional double patenting on other applications from the Applicant, and requests the Applicant, for the sake of avoiding any conceivable future prosecution delays because of double patenting, to determine if any other filed applications may also relate to the same subject matter and, if the Applicant will be filing a terminal disclaimer, add any additional applications that may fall under double patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9 & 13-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Muir et al. (U.S. Patent Application Publication No. 2005/0192090), which is the national stage of a PCT filed October 29, 2002 (WIPO No. 03/039699).

Claims 1-4, 6-9: Muir et al. discloses the same invention including a gaming machine having a first variable display means or display arrangement comprising of slot reels (paragraphs 0009 & 0065). Muir et al. also disclose the gaming machine, as known in the art, conducts a "lottery" to

determine an outcome of the slot game, in which stop control means performs a stop control of the reels (paragraphs 0041-0042 & 0045). Muir et al. also disclose a secondary display or "shielding means" overlaying the reels in such a way to create overlaying or overlapping images "on top of" (i.e. disposed in front of) the slot reels, as these slot reels include symbol images that are shown on the secondary display due to the transparency of the display (see "Summary of Invention" at paragraphs 0006-0031 & "Detailed Description" at paragraphs 0040-0070). The secondary display, or shielding means is an electronic mechanism, thus, is considered an "electronic shutter" since it either let's a player visually view the reels or blocks them from view. Additionally, the secondary display is controlled via a controller/processor to switch based on predetermined conditions between a transparent and opaque state, corresponding to a state in which a player can visually see the slot reels as their spinning and a state in which the player is disabled from visually seeing the slot reels (see "Summary of Invention" at paragraphs 0006-0031 & "Detailed Description" at paragraphs 0040-0070). Mur et al. also disclose controlling the transparency of the secondary display or shielding means when the reels have stopped spinning to overlay images on certain symbols as needed, and thus, the processor changing transparency via the controller/processor after reels have stopped is a "second control state" (figure 7 and the description thereof in which a portion of the symbols are shielded once the reels have stopped spinning). Therefore, any transparency changes to the shielding means via the controller/processor before the reels have stopped spinning are considered a "first control state".

Claim 5: Muir et al. disclose the invention of a display device overlapping the reels may be used within a base game or a special/bonus game (paragraph 0051). An example of what the Examiner interprets as a special gaming state is a bonus game which is entirely video based, such that the

first variable display is not needed and only the secondary display images are used within that purely video based bonus game.

Claims 13 & 15: Claims 13 and 15 are considered to incorporate the features discussed above in the explanation of claims 1-9, with some additional features discussed here. Muir et al. disclose "stop control selection means for selecting a kind of control of the stop control means in reference to a result of the lottery" and "the shielding control means performing, in accordance with a kind of stopping operation by the player, switch control between a first shielding state which is executed when the stopping operation matches the kind of stop control means, and a second shielding state which is executed when the stopping operation does not match the kind of the stop control means". This is seen within the game machine either determining the outcome will be a winning or loosing outcome, in which a winning outcome is considered a first stop control means and a loosing outcome is considered a second stop control means, such that the shielding is controlled dependent on the outcome. That is, Muir et al. disclose changes within the secondary display upon winning outcomes (see at least figure 7 and the related description thereof), however, with loosing outcomes, no effects from the secondary display occur, thus, the shield control states are different (i.e. a first and a second) dependent on the outcome of the "lottery".

Claim 14: As seen in figure 7, an effect image is displayed after the second shielding state, in which a particular symbol was shielded and "BONUS" was displayed over the shielded symbol position.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muir et al., as applied to claims 1-9 & 13-15, in view of Nishikawa (JP Publication No. 2000-300729). See attached English translation of abstract, detailed description, and claims.

Claims 10 & 12: Muir et al. disclose the invention substantially as claimed, but does not explicitly disclose shielding non-winning regions of an outcome for the purpose of highlighting or indicating the winning pay line(s) or symbol(s). Each of the other limitations of claims 10 and 12 have been addressed above in the explanation of claims 1-9 & 13-15. In addition, Muri et al. disclose adding animations over top of winning lines or symbols for the purpose of highlighting a win or wins (paragraph 0018). However, Nishikawa clearly discloses the feature of shielding the non-winning regions, such that only the winning regions are visually recognizable and indicated to the player for the purpose of highlighting or indicating wins to a player (see at least attached English abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Muir et al. as suggested by Nishikawa, by completely shielding non-winning lines or symbols in order to specifically distinguish the winning lines or symbols to a player for ease in determining what he/she has won.

Claim 11: Muir et al. disclose the invention of a display device overlapping the reels may be used within a base game or a special/bonus game (paragraph 0051). An example of what the Examiner interprets as a special gaming state is a bonus game which is entirely video based, such that the

first variable display is not needed and only the secondary display images are used within that purely video based bonus game.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Name	Reference	Applicability
Ozaki et al.	U.S. Patent Application Publication No. 2001/0031658	Similar concept with a secondary display disposed in front of a variable display.
Loose et al.	U.S. Patent Application Publication No. 2003/087690	Similar concept with secondary display disposed in front of a variable display.
Wells	U.S. Patent Application Publication No. 2004/0029636	A gaming device having a three dimensional display with multiple layers of displays through a single viewpoint.
Yamaguchi et al.	JP Publication No. 2001-062032	Display of light transmissive images, characters, lines, pictures, etc... on a display disposed in front of a variable display, and changing the transparency as needed.
Ozaki et al.	JP Publication No. 2001-238995	Superimposing display by overlapping displays and also discloses translucent displays over variable displays.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.B.S.

CORBETT B. COBURN
PRIMARY EXAMIN.